

REMARKS

Claims 136-139 have been added. Therefore claims 1-24, 51-73, 100-117 and 136-139 remain pending in the application.

Benefit of Priority:

The Examiner states that “[a]ll the claimed terms are not disclosed in the provisional applications; hence, applicant does not benefit the effective date as the provisional priority dates.” This statement by the Examiner is improper. The Examiner has the burden to present evidence or reasons why persons skilled in the art would not recognize support for the claim. *In re Wertheim*, 191 USPQ 90 (CCPA 1976). As stated by the Board of Patent Appeals & Interferences in *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (B.P.A.I. 1987), “a bare assertion by the Examiner” is insufficient for an assertion that a claim lacks support.

Applicants also remind the Examiner that the subject matter of a claim need not be described literally in order for the disclosure to satisfy the description requirement for a priority claim. As repeatedly stated by the Board of Patent Appeals & Interferences and by the Court of Appeals for the Federal Circuit, it is well settled law that the invention claimed [in the later application] does not have to be described [in the parent] *in ipsis verbis* in order to satisfy the requirements of §112. *Jacobs v. Lawson*, 214 USPQ 907, 910 (B.P.A.I. 1982). Applicants note that a proxy and bridging from a message-based computing environment to another computing environment is described in each provisional application (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority.

Objection to the Specification:

The Examiner objected to the Title as not being descriptive. The Title has been amended. Applicants respectfully request withdrawal of the objection to the Title.

In the Conclusion on p. 11 of the Office Action, the Examiner requests that the term “space” as used in the claims be replaced with the term “JavaSpace” because “space” can also be interpreted as a blank area. Applicants submit that Applicants’ use of the term “space” is clearly supported in Applicants’ specification. No one reading Applicants’ specification would interpret the term “space” in the claims to mean a blank space. Further, a “space” as claimed by Applicants’ is not necessarily the same as a JavaSpace. Therefore, the change suggested by the Examiner would not be appropriate.

The Examiner also states: “Even though, the applicant explained rational for the invention, i.e., pages 8-14, contains key terms like, CORBA, Java RMI, XML, Java, JavaSpace, Jini, advertisement, etc., the independent claims do not reflect this.” However, pages 8-14 in this section of the specification simply provide background information and are in no way limiting on Applicants’ invention. Nor does this portion explain the only rationale for the invention. There is nothing “key” about the terms used in this portion of the specification.

The specification has been amended to replace potentially active hyperlinks with descriptive URI/URL syntax identifiers.

Objection to the Drawings:

The Examiner objected to a typo in Fig. 50. A replacement sheet for Fig. 50 is enclosed herewith correcting the typo. The Examiner also requested that the term “space” be replaced with “JavaSpace” in the drawings. However, a space as described in Applicants’ disclosure is not necessarily implemented as a JavaSpace. Thus, the change requested by the Examiner would be misdescriptive. Elements in the drawings labeled “space” are clearly described in the specification. Thus, no confusion could result from the use of the term “space” in the drawings.

Information Disclosure Statements:

The Examiner states that Applicants' IDS dated 8/16/2001 is missing the form PTO-1449. However, Applicants have received a date stamped return postcard from the Office acknowledging receipt of form PTO-1449. For the Examiner's convenience, Applicants have provided herewith copies of both the original form PTO-1449 and the date stamped return postcard from the IDS dated 8/16/2001. Applicants request that the Examiner carefully consider each listed reference and return a signed and initialed copy of the form PTO-1449.

Additionally, per the Examiner's request, Applicants' are enclosing a complete copy of the publication, "XML and Jini – On Using XML and the 'Java Border Service Architecture' to Integrate Mobile Devices into the Java Intelligent Network Infrastructure", by Stefan Muller-Wilkin, Daniel Hinz, and Winfried Lamersdorf. Applicants originally only had possession of the first page of this reference. In response to the Examiner's request, both pages of the reference were located on the Internet.

Section 102(b) Rejection:

The Office Action rejected claims 1-5, 19-21, 23, 24, 52-55, 68-70, 72, 73, 100-103, 113, 114, 116 and 117 under 35 U.S.C. § 102(b) as being anticipated by Tuatini (U.S. Publication 2002/0032783). As set forth in more detail below, Applicants respectfully traverse the rejection as to the currently pending claims for at least the following reasons.

This rejection is improper because the Examiner has not shown that Tuatini qualifies as a prior art reference. The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that Tuatini qualifies as a prior art reference, the Examiner has not met this burden of proof and the rejection is improper. More specifically, the Tuatini patent was filed on January 2, 2001, after

Applicants' filing date of October 19, 2000. Tuatini does claim the benefit of provisional applications filed December 30, 1999. However, the December 30, 1999 filing date can only be used as Tuatini's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Tuatini patent and the provisional applications. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application(s), it is unclear whether the material in Tuatini relied upon by the Examiner was actually present in Tuatini's provisional applications. Therefore, Applicants request that the Examiner provide a copy of Tuatini's provisional applications and show that the subject matter on which the Examiner is relying on to reject Applicants' claims is also present in Tuatini's provisional applications. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, the Tuatini patent is not entitled to the December 30, 1999 date as a section 102(e) prior art date unless at least one claim of the Tuatini patent is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a patent is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. The rejection is improper unless the Examiner can show that Tuatini's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 102(e) prior art date. *See also* M.P.E.P. § 2136.03(IV).

Unless the Examiner can prove that BOTH of these requirements are met, the rejection must be withdrawn.

Section 103(a) Rejection:

The Office Action rejected claims 6-18, 56-67 and 104-112 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Beck et al. (U.S. Patent 6,604,140)

(hereinafter “Beck”) and further in view of Murphy et al. (U.S. Patent 6,604,127) (hereinafter “Murphy”).

The Murphy patent is not prior art to the present application for rejections under 35 U.S.C. § 103. The American Inventors Protection Act of 1999 amended 35 U.S.C. § 103(c) to state that art which qualifies as prior art only under § 102(e), (f) or (g) is not available for rejections under § 103 if that art and the subject matter of the application under examination were owned by or subject to an obligation of assignment to the same assignee at the time the invention was made. This change to 35 U.S.C. § 103(c) is effective for any application filed on or after November 29, 1999. The present application is an application for patent filed after November 29, 1999. At the time the invention was made, the subject matter of present application and the Murphy patent were both owned by or subject to an obligation of assignment to the same assignee, Sun Microsystems, Inc. Therefore, the amendment to 35 U.S.C. § 103(c) made by the American Inventors Protection Act of 1999 applies to the present application and operates to exclude the Murphy patent as available prior art for rejections under 35 U.S.C. § 103.

Thus, applicants respectfully request the removal of the 35 U.S.C. § 103(a) rejection of claims 6-18, 56-67 and 104-112.

The Office Action rejected claims 22, 71 and 115 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Applicants’ admitted prior art (hereinafter “AAPA”).

Regarding claim 22, the Examiner stated that it would have been obvious to combine the teachings of Tuatini and the AAPA because the AAPA’s use of Jini environment would provide access to the Jini services. Applicants disagree with the Examiner’s statement. Applicants submit that such a broad conclusory statement, as made by the Examiner, does not provide a sufficient motivation to combine the teachings Tuatini and the AAPA. “The factual inquiry whether to combine references must be

thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. “This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). “A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). The Federal Circuit has stated: “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed” (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the [Examiner] must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the [Examiner] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); See also, *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Just because the Jini environment was known in the prior art, does not mean that one of ordinary skill in the art would have been motivated to modify the teachings of Tuatini with the Jini environment. The Examiner has provided no objective evidence of record to the contrary. Applicants also respectfully remind the Examiner that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (M.P.E.P. § 2143.01, paragraph 8).

In light of the above remarks, applicants assert that the rejection of claim 22 is not supported by any evidence of record. Withdrawal of the rejection is respectfully requested. Similar remarks as discussed above in regard to claim 22 apply to claims 71 and 115.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-72200/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Petition for Extension of Time
- Notice of Change of Address
- Fee Authorization Form authorizing a deposit account debit in the amount of \$ for fees ().
- Original form PTO-1449 and date-stamped return postcard from IDS of 8/16/2001
- Complete copy of reference D1 from IDS of 11/17/2003.

Respectfully submitted,



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